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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/826,288

04/19/2004

Chien-Hua Chen

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11/19/2007

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

GHYKA, ALEXANDER G

ART UNIT

PAPER NUMBER

2812

MAIL DATE

DELIVERY MODE

11/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,288

Applicant(s)

CHEN ET AL.

Examiner

Alexander G. Ghyska

Art Unit

2812

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 19-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

ALEXANDER GHYKA
PRIMARY EXAMINER

AU 2812
AGH

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. The Applicants' arguments of 8/15/2007 have been considered and entered in the record. Applicants' arguments have been considered, but they are not persuasive for the reasons as discussed below. Claims 1-19 are under consideration

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 1-8, 11-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speakman (USPN 6503831) in view of Arney et al (US 5,235,187).**

Referring to Figs. 20 and related text, Speakman discloses [Re claim 1] a method of making a microelectromechanical system device comprising: releasing a micromover component 1302, and coating the micromover component with a first self-aligned film; [Re claim 2] wherein the step of coating comprises selectively depositing a coating composition only on the micromover component. (see col. 44,

lines 23-29); [Re claims 3-4] wherein the film comprises at least one of a polymer, PMMA and an epoxy photoresist; wherein the polymer is thermoplastic (see col. 44, lines 23-52). The Examiner notes that before being released the micromover cannot function as a MEMS (see col. 44, lines 22-28).

However, Speakman et al fails to disclose expressly coating the micromover component after releasing the micromover component.

Arney et al disclose methods of fabricating integrated self aligned tunneling tips which comprise a micromover. See Figures 1A and 2. Arney et al further disclose coating a piezoelectric film on a beam in order for the beam to be moved. See column 12, lines 10-20. Moreover, Arney et al disclose removal of the oxide leaves a gap between the isolated structure and the underlying substrate to release the support beam 24, wherever relative motion is desired. See column 17, lines 20-30. After the removal of the oxide (the release of the beam) the beam is coated. See column 17, lines 35-45 and lines 65-70.

It would have been obvious, for one of ordinary skill in the art, at the time of the invention, to release the micromover of Speakman et al and then coat the micromover, for its benefit in forming a micromover as discussed by Arney et al. As both references pertain to micromovers in MEMS, a *prima facie* case of obviousness is established. The use of a known method, as discussed by Arney, to form a known structure, as disclosed by Speakman et al is *prima facie* obvious. Moreover, the Examiner notes that selection of any order of performing process steps is *prima facie* obvious. See *In re Burnhaus*, 69 USPQ 330 (CCPA 1946).

[Re claim 5] Speakman also discloses wherein the polymer is thermoset (see col. 31, lines 11-17);

[Re claim 6] wherein coating the micromover component comprises adjusting a coating parameter to control the film thickness; [Re claim 7] wherein adjusting a coating parameter comprises selecting a solid to solvent ratio; [Re claim 8] wherein adjusting a coating parameter comprises selecting an amount of film material to deposit (see col. 2, lines 30-34, and col. 17, line 45-col. 18, line 34);

[Re claim 11] coating the micromover component with a second self-aligned film; [Re claim 12] wherein the second self-aligned film comprises a different material from the first self-aligned film (see col. 6, lines 21-34).

[Re claims 13-15] Speakman fails to disclose expressly wherein one of the self-aligned films comprises a thermoplastic polymer and the other comprises a thermoset polymer; wherein the first self-aligned film and the second self-aligned film have different hardness; wherein the first self-aligned film and the second self-aligned film have different glass transition temperatures. However, these would have been obvious in light of Speakman, which discloses a large variety of materials. The choice of the two materials depends on the desired characteristics of a specific application.

[Re claim 18] Speakman discloses wherein the first self-aligned film is adapted for data storage, anti-wear, anti-reflective, desiccant or an anti-stiction (see col. 11, lines 1-44).

Therefore, it would have been obvious to use the teaching of Speakman and Arney et al to obtain the invention as specified in claims 1-8, 11-15, and 18.

4. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speakman and Arney et al, as applied above, in view of Yao et al. (USPN 6617657, hereinafter "Yao").

Speakman and Arney et al disclose substantially the limitations of claims 9-10, as shown above. The references also disclose treating a surface of the micromover component prior to coating and applying an adhesion promoter to the micromover component (see col. 18, line 47-col. 19, line 3) of Speakman.

But it fails to disclose expressly the use of plasma treatment.

However, the missing limitation is well known in the art because Yao discloses this feature (See col. 5, lines 1-15).

A person of ordinary skill is motivated to modify Speakman and Arney et al with Yao to obtain clean surfaces with better adhesive property by a clean and well-proven method.

Therefore, it would have been obvious to combine Speakman and Arney et al with Yao to obtain the invention as specified in claims 9-10.

5. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speakman and Arney et al, as applied above, in view of Jacobson et al. (USPN 6587408, hereinafter "Jacobson").

Speakman and Arney et al disclose substantially the limitations of claims 16-17, as shown above.

But it fails to disclose expressly [Re claim 16] bonding a wafer having at least one contact probe or AFM tip opposite the self-aligned film; [Re claim 17] fabricating a contact atomic resolution storage device.

However, the missing limitations are well known in the art because Jacobson discloses these features (See Figs. 3C-3F and col. 8, lines 5-23).

A person of ordinary skill is motivated to modify Speakman and Arney et al with Jacobson to obtain high-density data storage.

Therefore, it would have been obvious to combine Speakman and Arney et al with Jacobson to obtain the invention as specified in claims 16-17.

Response to Applicants' Arguments

Applicants' set forth the standard to establish a *prima facie* case of obviousness, (MPEP 706.02 (j)) and argue that the Office Action fails to meet the burden of establishing a *prima facie* case of obviousness. Applicants further argue that the Office Action uses hindsight which is impermissible. Applicants argue that "although an Examiner may suggest that the structure of a primary prior art reference could be modified in view of a secondary prior art reference to form the claimed structure, the mere fact that the prior art could be modified does not make the modification obvious unless the prior art suggested the desirability of the modification. Applicants argue that the motivation to combine the two references is based on "the benefit as discussed by Arney et al", and that neither Speakman or Arney suggest a desirability for the Examiner's proposed modification.

As discussed in the previous Office action, the Examiner maintains that: "It would have been obvious, for one of ordinary skill in the art, at the time of the invention, to release the micromover of Speakman et al and then coat the micromover, for its benefit in forming a micromover as discussed by Arney et al. As both references pertain to micromovers in MEMS, a *prima facie* case of obviousness is established. The use of a known method, as discussed by Arney, to form a known structure, as disclosed by Speakman et al is *prima facie* obvious. Moreover, the Examiner notes that selection of any order of performing process steps is *prima facie* obvious. See *In re Burnhaus*, 69 USPQ 330 (CCPA 1946).

The Examiner has shown a reference in the prior art which discloses a device (a micromover) as claimed, but does not disclose the specified order in the process steps as required by the present Claims (the Speakman reference). Moreover, the Examiner has cited a second reference which also pertains to a micromover, and discloses the claimed process sequence. The motivation to combine is not "the benefit as discussed by Arney et al", as asserted by Applicants, but "its benefit in forming a micromover as discussed by Arney et al". As both references pertain to micromovers in MEMS, a *prima*

facie case of obviousness is established. One of ordinary skill in the art would be aware of the device of Speakman, and the process sequence of Arney, so the fabrication of the device of Speakman using the process sequence would be within the skill of one of ordinary skill in the art. In the present case the benefit would be the fabrication of the device, by a known method. Moreover, the Examiner notes that selection of any order of performing process steps is *prima facie* obvious. See *In re Burnhaus*, 69 USPQ 330 (CCPA 1946). In this case selecting a certain order to perform process steps, the sequence of which is known in the art, does not patentably distinguish over the cited prior art.

With respect to the rejections of Speakman and Arney in view of Yao and Speakman and Arney in view of Jacobson et al, Applicants argue the deficiencies of Speakman. The Examiner maintains that the burden of establishing a *prima facie* case of obviousness has been met for the reasons as discussed above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Application/Control Number:
10/826,288
Art Unit: 2812

Page 8

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander G. Ghya whose telephone number is (571) 272-1669. The examiner can normally be reached on Monday through Friday during general business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lebentritt can be reached on (571) 272-1873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AGG
November 7, 2007

ALEXANDER GHYKA
PRIMARY EXAMINER

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